

MORRISON & FOERSTER LLP
MICHAEL A. JACOBS (Bar No. 111664)
mjacobs@mofo.com
KENNETH A. KUWAYTI (Bar No. 145384)
kkuwayti@mofo.com
MARC DAVID PETERS (Bar No. 211725)
mdpeters@mofo.com
DANIEL P. MUINO (Bar No. 209624)
dmuino@mofo.com
755 Page Mill Road, Palo Alto, CA 94304-1018
Telephone: (650) 813-5600 / Facsimile: (650) 494-0792

BOIES, SCHILLER & FLEXNER LLP
DAVID BOIES (Admitted *Pro Hac Vice*)
dboies@bsflfp.com
333 Main Street, Armonk, NY 10504
Telephone: (914) 749-8200 / Facsimile: (914) 749-8300
STEVEN C. HOLTZMAN (Bar No. 144177)
sholtzman@bsflfp.com
1999 Harrison St., Suite 900, Oakland, CA 94612
Telephone: (510) 874-1000 / Facsimile: (510) 874-1460

ORACLE CORPORATION
DORIAN DALEY (Bar No. 129049)
dorian.daley@oracle.com
DEBORAH K. MILLER (Bar No. 95527)
deborah.miller@oracle.com
MATTHEW M. SARBORARIA (Bar No. 211600)
matthew.sarboraria@oracle.com
500 Oracle Parkway, Redwood City, CA 94065
Telephone: (650) 506-5200 / Facsimile: (650) 506-7114

Attorneys for Plaintiff
ORACLE AMERICA, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.

Plaintiff,

v.

GOOGLE INC.

Defendant.

Case No. CV 10-03561 WHA

**ORACLE'S APRIL 12, 2012 BRIEF
REGARDING COPYRIGHT ISSUES**

Dept.: Courtroom 8, 19th Floor
Judge: Honorable William H. Alsup

I. THE COPYRIGHT ACT PROTECTS A COMPUTER PROGRAMMING LANGUAGE THAT MEETS THE ORIGINALITY REQUIREMENT

The parties agree no case addresses directly whether the Copyright Act protects a computer programming language. However, the most analogous case law, general copyright principles, and the statutory purposes of the Copyright Act support protection. More importantly, none of the arguments advanced for denying protection to a programming language apply to the API specifications and class libraries at issue here.

The cases that have considered works most similar to a computer programming language are those involving codes or compilations of symbols. Courts have upheld copyright protection for codes or compilations of symbols that meet the originality requirement.

In *Reiss v. National Quotation Bureau, Inc.*, 276 F. 717 (S.D.N.Y. 1921), Learned Hand upheld copyright protection for a code book containing coined words that could be given an agreed meaning for the purpose of cable correspondence. Judge Hand compared the code to a language—“a set of words or symbols to form a new abstract speech, with inflections, but as yet with no meaning, a kind of blank Esperanto.” 276 F. at 718. He saw “no reason” why the code’s set of coined words could not be a “writing” protected by copyright simply “because they communicate nothing,” given that “[t]hey may have their uses for all that, aesthetic or practical, and they may be the productions of high ingenuity, or even genius.” *Id.* at 719; *see also Lotus Dev. Corp. v. Paperback Software Int.*, 740 F. Supp. 37, 72 (D. Mass. 1990) (rejecting argument “[t]hat not only languages such as English and French but all other languages as well – including Esperanto, and *Reiss*’ coined words, 276 F. at 718, and Pascal – are automatically ineligible for copyright protection”).

Similarly, in *Hatfield v. Peterson*, 91 F.2d 998, 1000 (2d Cir. 1937), the Second Circuit upheld copyright protection for a telegraphic code that was a compilation of non-original words and phrases, holding “the copyright is valid because of the originality of the combination.”

Courts have denied copyright protection to codes or systems of symbols only where they lack originality, not because they are inherently uncopyrightable. In *Toro Company v. R & R Products*, 787 F.2d 1208 (8th Cir. 1986), the Eighth Circuit rejected protection for a machine

1 parts numbering system because of lack of originality. But far from finding a set of symbols or a
2 language *per se* an uncopyrightable system, the court explained that: “A system that uses
3 symbols in some sort of meaningful pattern, something by which one could distinguish effort or
4 content, would be an original work.” 787 F.2d at 1213. Similarly, in *Brief English Systems,*
5 *Inc. v. Owen*, 48 F.2d 555 (2d Cir. 1931), the court rejected a claim for exclusive right to use a
6 published system of shorthand not because a code or language is inherently not copyrightable but
7 only because “[t]here is no literary merit in a mere system of condensing written words into less
8 than the number of letters usually used to spell them out.” 48 F.2d at 558.

9 Like the code of coined words in *Reiss*, a computer language may qualify for copyright
10 protection if it is sufficiently original. Indeed, to a much greater degree than the *Reiss* coined
11 words, it may and typically does represent very substantial creative work of exactly the kind that
12 copyright is intended to protect and promote, with “enough definite expression so that one may
13 distinguish authorship.” *Toro*, 787 F.2d at 1212.

14 Google argues that a programming language is “an uncopyrightable system or method of
15 operation,” “an idea, not expression.” Google 4/3 Br. at 14-15. But a work that represents only
16 one of many ways to perform a function is “the expression of a particular idea, not the idea
17 itself.” *Toro*, 787 F.2d at 1212; *see Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d
18 1240, 1253 (3rd Cir. 1983) (“If other programs can be written or created which perform the same
19 function as Apple’s operating system program, then that program is an expression of an idea and
20 hence copyrightable.”) As the Eighth Circuit explained in *Toro*:

21 All that the idea/expression dichotomy embodied in § 102(b) means in the parts
22 numbering context is that appellant could not copyright the idea of using numbers to
23 designate replacement parts. Section 102(b) does not answer the question of whether
24 appellant’s particular expression of the idea is copyrightable.

24 787 F.2d at 1212.

25 The fundamental “idea” of a computer programming language is to permit the user to
26 create an arrangement of symbolic commands that will direct a computer to perform specified
27 tasks. There may be lower-level ideas that are unprotectable as well, like a programming
28 language directed to a special purpose, or the idea of an object-oriented language. But these ideas

1 can be expressed in a wide variety of specific forms. While copyrighting a computer language
 2 cannot prevent others from designing programming languages that serve the same functions, the
 3 detailed vocabulary and written expression of the computer language should be protectable
 4 elements if sufficiently original and creative.

5 Adobe, for example, has asserted copyright protection for its PostScript computer
 6 language, and explains:

7 The general *idea* of using a page description language is in the public domain.
 8 Anyone is free to devise his or her own set of unique commands that constitute a page
 9 description language. However, Adobe Systems Incorporated owns the copyright for
 10 the list of operators and the written specification for Adobe's Post-Script language.
 11 Thus, these elements of the PostScript language may not be copied without Adobe's
 12 permission.

13 Adobe Systems Inc., POSTSCRIPT LANGUAGE REFERENCE xiii and 9 (3d ed. 1999), available at
 14 <http://www.scribd.com/doc/202357/PostScript-Language-Reference-Third-Edition>. In asserting
 15 its copyright, Adobe has stated that one of its objectives is to “[m]aintain the integrity of the
 16 PostScript language standard.” *Id.* at 9.

17 Google relies primarily on preliminary opinions in a pending English case recently
 18 referred to the European Court of Justice (“ECJ”). The ECJ has not yet responded to that referral.
 19 *SAS Institute, Inc. v. World Programming Ltd.*, [2010] EWHC (Ch) 1829. The ECJ will not
 20 interpret the U.S. Copyright Act; it will decide the case under the extensive relevant provisions of
 21 European treaty law and the EEC Software Directive and related case law (*id.* at ¶¶ 149-95), as
 22 well as the legislative history of the Directive and its adoption by the European Parliament (*see*
 23 *id.* at ¶¶ 211-227). The English court referred the programming language question to the ECJ for
 24 the very reason that its resolution was not “*acte clair*,” that is, free from reasonable doubt.

25 Google relies, in particular, on the opinion to the ECJ by Advocate General Opinion.
 26 Opinion of Advocate General Bot, *SAS Institute v. World Programming Ltd.*, Case C-406/10
 27 (“SAS Advocate General Opinion”). Google cites the following passage:

28 It seems to me, therefore, that programming language is a functional element which
 allows instructions to be given to the computer. As we have seen with SAS language,
 programming language is made up of words and phrases known to everyone and
lacking originality. In my opinion, programming language must be regarded as
comparable to the language by the author of a novel. It is therefore the means
 which permits expression to be given, not the expression itself.

1 *Id.* at ¶ 71 (emphasis added). This analysis ignores the obvious difference that the language used
2 by a novelist, unlike an original computer language, is not itself the author’s work of original
3 creative expression. The novelist does not create the language in which she writes.

4 In concluding that a computer language is “lacking originality,” Advocate General Bot’s
5 opinion is also at odds with U.S. case law. Even “[a] factual compilation is eligible for copyright
6 if it features an original selection or arrangement of facts.” *Feist Publications, Inc. v. Rural Tel.*
7 *Serv. Co.*, 499 U.S. 340, 350 (1991). Copyright protection is denied based on lack of originality
8 only to “a narrow category of works in which the creative spark is utterly lacking or so trivial as
9 to be virtually nonexistent.” *Id.* at 359. Unlike the white pages at issue in *Feist*, a typical
10 computer programming language represents creative work in its selection and arrangement of
11 symbols that may be sufficient to meet the “originality” requirement.

12 Moreover, and of more significance to this case, despite opining that a computer
13 programming language may not be copyrightable, Advocate General Bot concluded that an
14 interface may be. He found that the Directive “does not exclude interfaces from copyright
15 protection” and that “if the expression of the interface constitutes a substantial part of the
16 expression of the computer program . . . it is eligible for protection under the Directive.” SAS
17 Advocate General Opinion, at ¶¶ 81-82; *see also id.* at ¶ 60 (elements of a program enjoy
18 protection “provided that they contain some of the elements which are the expression of the
19 intellectual creation of the author of the work”).

20 Copyright protection of a computer language is also consistent with the Copyright Act’s
21 statutory purpose to “*promote* the creation and publication of free expression” by rewarding
22 authors. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (emphasis in original). Developing an
23 original, never-before-written language—whether a computer programming language or a newly
24 coined language for a dramatic production such as Na’vi (from the film *Avatar*) and Dothraki
25 (from the HBO series *Game of Thrones*)—may represent years of creative work. Copyright
26 protection rewards and promotes those creative efforts. The estate of J.R.R. Tolkien, for
27 example, has asserted copyright protection for Elvish and other languages used in his works.

28 <http://www.theodoramichaels.com/articles/fan-fic.php#Languages>

1 The policy balance to apply to the idea/expression dichotomy was described by the Ninth
2 Circuit in *CDN Inc. v. Kapes*, which affirmed copyrightability of a collectable coin pricing guide:

3 As Judge Hand noted, the difference between idea and expression is one of degree.
4 This circuit has held that “[t]he guiding consideration in drawing the line is the
5 preservation of the balance between competition and protection reflected in the patent
6 and copyright laws.” *Rosenthal*, 446 F.2d at 742. In this case, the prices fall on the
7 expression side of the line. CDN does not, nor could it, claim protection for its idea
8 of creating a wholesale price guide, but it can use the copyright laws to protect its
9 idea of what those prices are. . . . Drawing this line preserves the balance between
10 competition and protection: it allows CDN’s competitors to create their own price
11 guides and thus furthers competition, but protects CDN’s creation, thus giving it an
12 incentive to create such a guide.

13 197 F.3d 1256, 1262 (9th Cir. 1999) (citations omitted). Protecting the expression embodied in a
14 computer language while allowing competitors to create their own languages with parallel
15 purpose and function preserves the balance between competition and protection.

16 As demonstrated above, the best view of U.S. copyright law is that an original and
17 creative computer language is subject to copyright protection as an “original work[] of
18 authorship.” 17 U.S.C. § 102. As far as Oracle has been able to determine, neither Oracle nor
19 Sun has taken a contrary position on the copyrightability of computer languages.

20 **II. HISTORY OF API DEVELOPMENT**

21 Modern APIs owe their origins to the development of modular programming.
22 Subroutines, first invented in 1951, divided programs into units with specific tasks. The first
23 software libraries were collections of common, general-purpose subroutines that could be re-used
24 in different programs. These libraries were not considered part of the language in which they
25 were written. They were sets of reusable program modules, expressed in particular languages.

26 The use of an API as a specification of how software modules interact arose during the
27 1970s. One example from that time is *prototypes* written in the C programming language.
28 Prototypes are fragments of code describing the sets of parameters to be passed to different
subroutines and the types of their return values. Developers combined these code fragments with
English prose specifying the behavior of the subroutines, creating API specifications similar to
those written today. Other developers could learn from the API specifications how different
libraries worked without having to study their underlying implementations.

1 The techniques of modular program development are more relevant today than ever.
2 Professor Mitchell will testify that today's software systems are among the most complex
3 products ever created by human beings, and APIs are the core structuring concepts software
4 designers use to manage this complexity. (Mitchell Opp. Rep., ECF No. 397-1 ¶ 18.) Software
5 developers often collaborate on projects from different cities or countries. (*Id.* ¶ 25.) They use
6 APIs to understand the potential dependencies between different sections of code without having
7 to know how the code for an entire project works. A developer in San Francisco, for example,
8 can design an API for a library and then design and implement the library. A colleague in Paris
9 need only consult the API in order to make use of that library; there is no need to know the inner
10 workings of the library.

11 **III. THE JAVA APIS ARE NOT PART OF THE PROGRAMMING LANGUAGE**

12 **A. A programming language and an API are distinct things with different** 13 **purposes**

14 The evidence will show that a programming language and an API are two very different
15 things. A programming language is an artificial language used to create programs that control the
16 behavior of a machine. An API implementation (often referred to as a "class library") is a
17 computer program component that consists of pre-written code. The API specification is the
18 blueprint to the class library. It is a detailed written description of the programs that explains how
19 the programs are structured, how they are to be used, and what they will do. For example, a
20 library implementing a database API will provide database functions, a library implementing a
21 networking API will provide networking functions, a library implementing a mathematics API
22 will provide arithmetic and trigonometric functions, and so forth.

23 Google was never confused about the distinction between an API and a programming
24 language when this case began or for long afterwards. Google is now straining to change course
25 to take a position it knows is factually incorrect. At the outset, Google acknowledged that the
26 class libraries are distinct from the Java programming language. (*See* ECF No. 51 at 13-14.)
27 Google's expert stated that the Java programming language and the Java APIs are "very different
28 things." (Astrachan Opening Rep., ECF No. 262-1 ¶ 7.) He defined an API as "a particular set of

1 rules and specifications that software programs can follow to communicate with each other. It
2 serves as an interface between different software programs and facilitates their interaction, similar
3 to the way the user interface facilitates interaction between humans and computers.” (*Id.* ¶ 24.)

4 One area where the parties’ experts agree is that there are very few classes within the Java
5 APIs that must be present for the Java language to function. Oracle’s expert will testify that “it
6 was not necessary to include any particular class or package (beyond perhaps a very few classes
7 like Object and Class that are tied closely to the Java language) for the Java language to
8 function.” (Mitchell Opp. Rep., ECF No. 397-1 ¶ 20.) Google’s expert testified in deposition
9 that he agrees:

10 Q. Paragraph 20. And Dr. Mitchell says, in around the middle of the paragraph, “It is
11 important to realize that while the robust and elegant API specification and class
12 libraries that implement them have been important to Java’s success, it was not
13 necessary to include any particular class or package beyond perhaps a very few
14 classes like object and class that are tied closely to the Java language for the Java
language to function.” And maybe that’s the missing piece here. I mean, do you
have an opinion on what classes were required to be included in order for the Java
language to function?

15 A. I think this accurately reflects what the Java language needs to function.

16 (9/9/11 Astrachan Dep. 230:19-231:8.)

17 The Java Language Specification defines what is in the Java programming language. That
18 definition includes those few classes, but otherwise does not include these 37 API packages.

19 **B. The Java APIs Are Deliberately Maintained Separately From The
Java Programming Language**

20 The Java APIs are deliberately from the Java programming language. This was done very
21 deliberately. They should not be regarded as part of the language.

22 One example of how the Java APIs are distinct from the Java programming language is
23 that, while the Java programming language has changed very little since it was first released in
24 1996, the Java APIs have grown explosively. In 1996, there were only 7 API packages. There
25 are now 209 API packages for Java Standard Edition (“SE”) alone.

26 Since developers could program in Java from the time of its first release, it is obvious that
27 these additional 202 APIs are not required to use the programming language. Many of these APIs
28 contain highly specialized functions that would be neither expected nor, in many cases, desirable

1 in a general purpose programming language. This is true of most of the 37 API packages at issue
2 in the case. Javax.net, for example, concerns a group of methods relating to creating a secure web
3 connection. Javax.crypto, javax.crypto.interfaces, and javax.crypto.spec all relate to methods of
4 encrypting and decrypting data. Java.text is an API package containing methods to help make a
5 computer program usable in multiple natural languages.

6 The Java APIs are kept separate from the programming language for good reasons. When
7 a programming language is created no one can predict all the ways it will be used. No one can
8 foresee all the APIs that will be needed, and it is a mistake to build too much into the language.
9 For example, there is no reason to build a database API into a general-purpose language like Java.
10 As database technology improves and evolves, developers can create new APIs as needed, but the
11 language should not also have to evolve. The C programming language is one of the most
12 powerful and widely used languages, and it is still recognizable to programmers who used it in
13 the 1970's, even though the uses to which the language is put have changed dramatically.

14 If a particular API were part of the language, then every change or addition to the API
15 would have a ripple effect through everyone who uses or depends on the language, and would be
16 required to implement the new features. It is for this reason that the Java language has changed
17 only three times since it was first released and the process for changing the language is extremely
18 deliberate and slow. Changes to the language require a super-majority vote of the entire
19 Executive Committee of the Java Community Process and have only occurred after a lengthy
20 public approval process. Changes to API's can be made much more quickly.

21 Another reason why the Java APIs are kept separate from the programming language is
22 that Java is used to write programs for devices of very different capabilities, from powerful
23 servers to embedded microcontrollers in single chips. Trying to implement all API elements as
24 part of the Java language would require a heavyweight Java Virtual Machine capable of
25 implementing every part of their functionality regardless of the device. In addition, the same API
26 may provide different functions on different device form factors, and making every API part of
27 the base language would make this impossible. The solution instead is to select, develop, and
28 specify different sets of APIs suitable for different environments. This is exactly what Sun did in

1 the early days of Java when it divided Java into the language on the one hand and different
2 collections of APIs on the other—Java SE (for desktops and servers), Java EE (for large scale
3 enterprise applications), Java ME (for mobile and embedded devices).

4 Oracle may properly claim copyright protection over the Java APIs even if the Java
5 programming language is freely available. The evidence at trial will show that copyright notices
6 were prominently and consistently displayed on the API specifications. Hundreds of the world's
7 largest companies pay to license the Java platform. Google was well aware of the requirement to
8 license the specifications. Andy Rubin took a license to the Java specifications when he was at
9 his predecessor company, Danger. Sun expressly rejected the notion that Danger did not require a
10 license because Rubin had created an independent implementation, and therefore Danger paid.
11 Rubin wrote in an internal email at Google and confirmed in his deposition that he was aware that
12 Sun claimed copyright protection for the APIs. (TX0018; 7/27/11 Rubin Dep. 149:18-150:13.)

13 **C. The Existence Of Java APIs And Class Libraries Besides The APIs At Issue**
14 **Shows That APIs Are Not Inherently Part Of The Language And Why**
15 **Google's Copyrightability Position Is Incorrect**

16 The evidence will also show that there are many Java-language APIs and class libraries,
17 available from a wide variety of sources, that are also not considered part of the Java
18 programming language.

19 A good example is Android itself. Android has many APIs besides the 37 packages that
20 give rise to copyright liability in this case. Many of them have the same purpose as some of the
21 Java SE APIs Google did *not* copy.¹ Google provides compatibility test suites for its licensees to
22 confirm that they are compatible with its APIs using those test suites. But this does not mean that
23 any given Android API is part of the Java programming language. Oracle's Java APIs should not
24 be analyzed differently.

25 Beyond Android, the world is full of Java APIs and libraries. None are considered to be
26 part of the Java language either. The website freecode.com lists over 1,100 different Java

27 ¹ This shows the Java APIs are expression, not ideas, since there are corresponding APIs that
28 implement the same idea (*e.g.*, a library to handle screen displays and user interactions) but have
different designs.

1 libraries. See <http://freecode.com/tags/java-libraries>. Many third parties provide class libraries
2 and APIs for specialized Java applications like financial trading. For example, competitors IBM
3 and BEA jointly developed a series of API specifications to create a common data programming
4 environment for their competing server products. And scores of other companies create their own
5 libraries and APIs internally so they can re-use code.

6 Google's position is that *none* of these APIs could ever be copyrighted because "APIs are
7 not copyrightable, regardless of the programming language." (See ECF No.778 at 6-7 ("all API
8 specifications, by design, describe precisely the elements of APIs that are needed for
9 compatibility between implementations of the APIs, and with programs that use the APIs").)
10 This does not make sense or comport with the law. The class libraries are copyrightable as a
11 computer program, and their selection, arrangement and structure is copyrightable if sufficiently
12 original and creative. The written description of those class libraries is copyrightable as well.

13 **IV. HOW APIS ARE VIEWED IN OTHER LANGUAGES**

14 The class libraries and APIs in other computer languages are generally not viewed as part
15 of the programming language, even when a core set of APIs is specified in the same document as
16 the programming language specification. The size and richness of these libraries varies widely.
17 For example, C++, an object-oriented programming language similar in some ways to Java, was
18 associated with a much smaller set of libraries. As a result, several different entities have created
19 more comprehensive libraries and APIs, including the Standard Template Library and the Boost
20 C++ Libraries. The Perl programming language also comes with a small set of libraries, called
21 subroutine modules. However, over 100,000 additional modules are available separately in the
22 CPAN Archive. See <http://www.cpan.org/index.html>. The Python software platform took the
23 opposite approach and comes with an extensive set of libraries even larger than Java's, yet the
24 Python documentation is clearly divided into separate descriptions of the language and the
25 libraries. Even with such a large set of built-in libraries, over 20,000 additional packages are
26 available at the Python Package Index. <http://pypi.python.org/pypi>.

1 Dated: April 12, 2012

MORRISON & FOERSTER LLP

2 By: /s/ Michael A. Jacobs

3 *Attorneys for Plaintiff*
4 ORACLE AMERICA, INC.